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EXAMINER

TUCKER, PHILIP C

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 02/06/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

770848

Applicant(s)

PATEL

Examiner

P. TUCKER

Group Art Unit

1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 11/27/02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1 - 18, 23, 24 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1 - 18, 23, 24 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by EP 137538.

EP '538 teaches an invert emulsion composition comprising the same surfactant as in the present invention, which is used as a drilling fluid (See page 7, lines 1-6, Examples 10, 12 and 13). Applicants discovery of the reversible property does not distinguish over the prior art (In re Tomlinsin 150 USPQ 623).

3. Claims 1-18, 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Mueller (5254531).

Mueller teaches an invert emulsion composition comprising an ester oil phase, salted aqueous phase, weighting agent and compounds which are the same as surfactant in the present invention (see the surfactant  $R-NH-(CH_2)_n-NH_2$  in column 6), which is used as a drilling fluid

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(See column 6, lines 1-29 and column 10, lines 8-20). Applicants discovery of the reversible property does not distinguish over the prior art (In re Tomlinsin 150 USPQ 623).

4. Claims 1-8, 11-18, 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Voda (3125517).

Voda teaches an invert emulsion composition comprising the same surfactant as in the present invention, which is used as a drilling fluid (See examples). Applicants claim 10 and specification teaches that the weighting agent may be sodium chloride, thus the teaching of the use of seawater or salt water by Voda anticipates the current claims (see column 3, lines 48-60). Applicants discovery of the reversible property does not distinguish over the prior art (In re Tomlinsin 150 USPQ 623).

5. Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by Bleeker et al. (4670550).

Bleeker teaches an invert emulsion composition comprising the same surfactant as in the present invention, which is used as a drilling fluid (See Examples 10, 12 and 13). Applicants discovery of the reversible property does not distinguish over the prior art (In re Tomlinsin 150 USPQ 623).

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***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-18, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller (5254531).

Mueller teaches an invert emulsion composition comprising an ester oil phase, salted aqueous phase, weighting agent and compounds which are the same as surfactant in the present invention (see the surfactant  $R-NH-(CH_2)_n-NH_2$  in column 6), which is used as a drilling fluid (See column 6, lines 1-29 and column 10, lines 8-20). The compounds described by Mueller in which  $n$  is 2 (a preferred value), and  $R$  comprises up to 22 carbon atoms corresponds to compounds of the present invention in which  $x+y=1$ . Mueller differs to the extent that the use of a specific example of such amine compound is not taught. To the extent that the present claims are not anticipated, it would be obvious to one of ordinary skill in the art to utilize the compounds of Mueller of formula  $R-NH-(CH_2)_n-NH_2$  in the invert emulsion, given the teaching of Mueller that such compounds improve the flowability of the invert emulsion drilling fluid. Applicants discovery of the reversible property does not distinguish over the prior art (In re Tomlinsin 150 USPQ 623).

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***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 23-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6218342. Although the conflicting claims are not identical, they are not patentably distinct from each other because

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although the claims of the present invention differ by not being in independent form, the claims of both the present application and the patent teach the same method utilizing the same surfactants, which would render the claims of the present application obvious to one of ordinary skill in the art over the claims of US 6218342.

10. Applicants arguments have been considered but are not deemed fully persuasive. Applicants amendment to include has distinguished over the EP and Bleeker references, except with reference to claim 23, which does not teach a weighting agent.

With respect to Mueller, the Araphen G2D differs from emulsifiers of the present invention as applicant has stated. However, Mueller teaches other amine surfactants within the scope of the present invention, such as listed in column 6 therein, and clearly teaches the use of weighting agents therein.

The Voda reference clearly teaches the use of seawater or salt water as the aqueous phase, and is thus not distinguished from applicants claims, since sodium chloride is listed as a weighting agent for the emulsions.

Applicant has stated that a terminal disclaimer has been filed, but as of the present time, a terminal disclaimer has not been received in the file wrapper of this application, and thus the obviousness double patenting rejection is maintained.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tucker whose telephone number is (703) 308-0529. The examiner's normal working hours are 7:30am-4:00pm, Monday-Friday. If necessary SPE Robert Dawson may be contacted at 703-308-2340. For inquiries of a general nature call the receptionist at 703-308-0651. The group FAX no. is 703-872-9310. The **after final** fax no. Is 703-872-9311.

PCT-2733  
February 5, 2003

  
**PHILIP C. TUCKER**  
**ART UNIT 1712**